

REMARKS

The Examiner objected to the Applicants' Amendment filed on June 18, 2003 because:

- 1) a complete listing of all of the claims were not presented in the Amendment;
- 2) the listing of claims did not include the text of all claims currently under examination; and
- 3) the claims in the Amendment filed June 18, 2003 were not presented in ascending numerical order.

As will be seen by the new Listing of Claims submitted herewith, the complete text of all of claims 1-15, including withdrawn claims 8-14, has now been included in the Listing of Claims. Accordingly, it is believed that the Amendment is now in compliance with the revised amendment practice.

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-15 are currently being prosecuted. The Examiner is respectfully requested to reconsider his rejections in view of the Amendments and Remarks as set forth hereinbelow.

WITHDRAWN CLAIMS

The Examiner has proceeded to make his restriction requirement final and has withdrawn consideration with regard to claims 8-14. The Examiner is respectfully requested to reconsider his restriction requirement. For the reasons as set forth in Applicants' Response

to a Restriction Requirement filed on January 22, 2003, it is respectfully submitted that a burden would not be placed on the Examiner to consider all of the claims in a single application. Reviewing the prior art cited by the Examiner in his Office Action it is clear that the Examiner did search outside of Class 53, Subclass 459. Thus, the Examiner is respectfully requested to act on all of the claims of the present application.

If the Examiner continues with his restriction requirement, Applicants reserve the right to file a divisional application directed to the non-elected claims at a later date if they so desire.

CLAIM FOR PRIORITY

It is gratefully acknowledged that the Examiner has recognized the Applicant's claim for foreign priority. In view of the fact that the Applicant's claim for foreign priority has been perfected, no additional action is required from the Applicants at this time.

DRAWINGS

The Official Draftsperson has not approved the Formal Drawings submitted by the Applicants with the originally filed application papers and as corrected in the Letter to the Official Draftsperson dated December 6, 2001. It is respectfully submitted that the drawings comply with the requirements of the USPTO. If the Official Draftsperson has any objections to the Formal Drawings he/she is respectfully requested to contact the undersigned as soon as

possible so that appropriate action may be taken. No further action is believed to be necessary at this time unless the undersigned receives a notice from the Official Draftsperson.

ACKNOWLEDGEMENT OF INFORMATION DISCLOSURE STATEMENT

The Examiner has acknowledged the Information Disclosure Statements filed on August 9 and November 8, 2001. An initialed copy of the PTO-1449 has been received from the Examiner. No further action is necessary at this time.

OBJECTION TO THE SPECIFICATION

The Examiner has objected to Page 4 of the specification for containing references to patent claims. As the Examiner will note, Page 4 has been amended to delete the references to patent claims. The Examiner's objection has been obviated.

OBJECTION TO THE CLAIMS

The Examiner has objected to Claim 1, lines 12 and 18. As the Examiner will note Claim 1 4 has been amended to incorporate the Examiner's helpful suggestions. The Examiner's objection to the claims has been obviated.

REJECTION UNDER 35 USC 112

Claims 5-7 stand rejected under 35 USC 112 as being indefinite. This rejection is

respectfully traversed.

As the Examiner will note, Claim 5 has been amended to change “and/or” to -- or --. In addition, Claim 15 has been added to claim the subject matter with the use of the word “and.” In addition, antecedent basis has been provided for “said rolls.”

Further, Claim 6 has been amended to provide antecedent basis for “an end phase of said pulling-over.” In addition, Claim 7 has been amended to provide antecedent basis for the “rolls.”

It is respectfully submitted that the Applicants have complied with the requirements of the Examiner. The rejection based on 35 USC 112 has been obviated.

REJECTIONS UNDER 35 USC 102 and 103

Claims 1, 2 and 5-7 stand rejected under 35 USC 102 as being anticipated by Birkenfeld, DE 4307287. Claims 3 and 4 stand rejected under 35 USC 103 as being unpatentable over Birkenfeld. These rejections are respectfully traversed.

It is respectfully submitted that claims 1, 2 and 5-7 are not anticipated by the prior art cited by the Examiner. As set forth in Section 2131 of the MPEP Original Eighth Edition, August, 2001, page 2100-68:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claims.” *Richardson v.*

Suzuki Motor Co., 868 F2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Birkenfeld (DE 4307287) is directed to a state of the art method for packing objects in a stack according to the steps disclosed in the preamble of claim 1 of the present application, wherein said tension of said foil or band stock is controlled. This known method controls the tension of a foil during the step of pulling-over of the foil, i.e. during vertical movement of gripper means along the sides of the stack. It is understood that this tension control also takes place at the beginning of the pulling-over in the region of the upper side of the stack of goods, with the goal to avoid overstretching and to achieve a better fit of the foil to this region of the stack.

Contrary to Birkenfeld, it is the object of the present invention to avoid excessive stretching of the foil or the band stock, respectively, on the upper surface of the stack, as discussed in the present application at Page 4, lines 2-4, during teetering of the foil. By the method disclosed in the present invention the horizontal stretch of said foil can be adjusted as discussed in the present application at Page 5, lines 1-3.

This control takes place during the essentially horizontal movement of the gripper means for tentering of the foil on the upper side (surface) of the stack of goods as disclosed in the present application at Page 5, paragraphs 2 and 3 of the description, especially with the wording "an the upper side (surface) of the stack of goods." See Page 5, lines 1-3 of the present application and Fig. 2b, 2c.

Claim 1 is directed to a combination of method steps that includes controlling tension of said foil hood or band stock, respectively, during tentering in essentially a horizontal direction on the upper side of said stack of goods which is supported by the above mentioned citations in the specification of the present application.

This subject matter of the present invention is not anticipated by the Birkenfeld patent since the Birkenfeld patent does not disclose the combination of method steps wherein the tension during tentering in an essentially horizontal direction on the upper side of said stack of goods is controlled. In the contrary, Berkenfeld discloses a method wherein the stretch of the foil during vertical movement in the step of pulling-over is controlled. By that an existing tension is adjusted by an additional vertical stretch in the region of the side surfaces of the stack. See, the Birkenfeld patent col. 3, lines 23 to 54. In this region, the horizontal position of the gripper means can also be adjusted to follow the contour of the stack.

No evidence whatsoever could be found in the specifications and claims of Birkenfeld patent that the stretch of the foil during tentering on the upper side of the stack is controlled See, the Birkenfeld patent col. 5, lines 6 to 19, and Fig. 1, since no rolls or control means are involved during the step of tentering.

The disclosed subject matter of the present invention is also unobvious over the Birkenfeld patent since it is not obvious in the disclosure set forth in the Birkenfeld patent to control the tension of a foil during tentering on the upper side of the stack. The object of Birkenfeld patent is to create a method for packing a stack of goods with different cross

sections along its height by a foil in a perfect manner whereby overstretch is avoided. This problem is solved by adjusting the tension of the foil in the region of the side surfaces of the stack during vertical pulling-over of the foil. Thus, Birkenfeld solves a complete different problem compared to the present invention. It is therefore not made obvious to a skilled person to apply the method disclosed by Birkenfeld for solving the problem of avoiding excessive stretching of the foil or the band stock, respectively, during tenting on the upper surface of the stack.

It is respectfully submitted that the prior art cited by the Examiner does not set forth each and every method step as defined in the claims. Thus, the Examiner's rejection based on 35 USC 102 has been obviated. In addition, the combination of method steps as set forth in the present invention is clearly unobvious over the Birkenfeld patent.

NO PROSECUTION HISTORY ESTOPPEL

Claims 1-7 have been amended to comply with the provisions of 35 USC 112. No prosecution history estoppel would apply to the interpretation of the limitations set forth in claims 1-7 in view of the fact that this subject matter has been continuously presented since the original filing date of the present application.

CONCLUSION

In view of the above remarks, it is believed that the claims clearly distinguish over the patents relied on by the Examiner, either alone or in combination.

Since the remaining patents cited by the Examiner have not been utilized to reject the claims, but to merely show the state of the art, no comment need be made with respect thereto.

In view of the above amendments and remarks, reconsideration of the rejections and allowance of all of the claims are respectfully requested.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (703) 205-8000 in the Washington, D.C. area.

A prompt and favorable consideration of this Amendment is respectfully requested.

Application No. 09/924,528

Art Unit: 3721

Atty. Docket: 0430-0160P

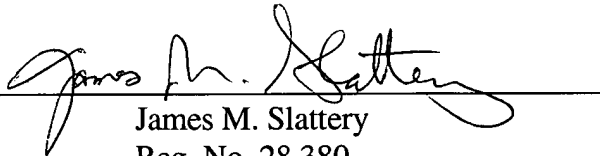
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

A handwritten signature in black ink, appearing to read "James M. Slattery", is written over a horizontal line.

James M. Slattery

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